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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,580	10/23/2006	Richard Fouquer	011460.00037	1073
26712 7590 02/21/2008 HODGSON RUSS LLP THE GUARANTY BUILDING 140 PEARL STREET SUITE 100 BUFFALO, NY 14202-4040				
EXAMINER				
ADDRESSEE, SARA				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/590,580

**Applicant(s)**

FOUQUER, RICHARD

**Examiner**

SARA ADDISU

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/5506)
- Paper No(s)/Mail Date 8/24/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The abstract of the disclosure is objected to because it is in claim format and contains legal phraseology, e.g. "comprises".. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,
  - the "curved posterior periphery", the "curvature that is variable" and the "concave lateral supporting faces" (as claimed in claims 3, 4 and 6) and
  - the "an overall parallelogram shape" of the anterior layer of the insert (as claimed in claim 10)
  - the "angles" (claimed in claims 5, 11 and 14)must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Claim 10 recites "... the large anterior face has an overall parallelogram shape". Further review of the figures do not show a

parallelogram shape. It is not clear how the shape could be considered "an overall parallelogram shape" when the insert has not parallel cutting edges (i.e. cutting edges that form v-shape such as 13a & 13b and 15a & 15b).

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 recites "a reversible cutting insert". It is not clear to the Examiner how the insert is "reversible" especially when the cutting edges are located only on one side while the opposite side is for supporting the insert on the toolholder. For the purpose of this Office Action, Examiner is interpreting it to mean "an indexable insert".
- Claim 10 recites "... the large anterior face has an overall parallelogram shape". Further review of the figures do not show a parallelogram shape. It is not clear how the shape could be considered "an overall parallelogram shape" when the insert has not parallel cutting edges (i.e. cutting edges that form v-shape such as 13a & 13b and 15a & 15b). For the purpose of this Office

Action, Examiner is interpreting it as not being non-parallelogram shape.

- Claim 11 recites ".....consecutive pairs of lateral framing supporting faces are mutually inclined at an angle ranging between 65 and 85 degrees". Applicant has not given a point of reference (i.e. the inclined supporting faces are measured in relation to what plane?).
- Claim 9 recites "... the anterior layer portion is delimited by two overlapping truncated pyramids having different tapers. Further review of the Specification and figures do not clarify the claimed subject matter. It is not clear to the examiner what parts are considered to be "two overlapping truncated pyramids" and which portions is the Applicant considering to be " different tapers".
- Claim 12 (lines 6-8) recites " a\_first specific\_number" and "a second specific number". It is not clear what the claimed subject matter is.
- Claim 14 recites "... The walls of the seat are mutually inclined at an angle ranging from 65 to 85 degrees". Applicant has not given a point of reference (i.e. the inclined supporting faces are measured in relation to what plane?).
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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

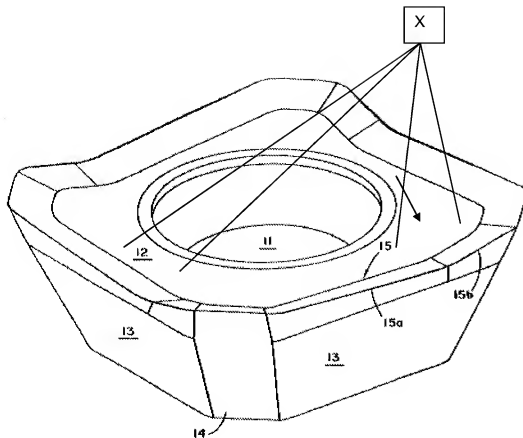
Claims 1, 2, 5, 7-10, 12, 13 and 15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Satran et al. (EP 0548752 A1).

Regarding claims 1, 2 and 10, SATRAN ET AL teaches an indexable cutting insert comprising an anterior layer cutting head portion (i.e. top portion) comprising mutually inclined lateral faces (X: see figure below) of an anterior periphery and delimiting together with a large anterior face (12), a front view profile formed by a certain number of cutting edges (15a, 15b) mutually inclined in the direction (see arrow below) of said profile, and a posterior layer portion (i.e. bottom portion), constituting an anchoring base on a tool holder, comprising planar lateral faces (13) of a posterior periphery, at least some of which are framing supporting faces on walls of a seat of the tool holder (16), characterized in that the posterior periphery (13) comprises a smaller number of lateral framing supporting faces than the number of cutting edges (i.e. there are four posterior lateral faces (13) while there are eight cutting edges (15a & 15b) ('752, figure 1). Regarding claims 7 and 8, SATRAN ET AL teaches the lateral framing supporting faces of the insert having an overall truncated pyramid shape ('752, figure 1

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and also as evidenced by USP 5,951,214, col. 1, lines 30-32). Regarding claims 5 and 9, as best understood, SATRAN ET AL teaches in figure 5, said successive lateral framing supporting faces being joined together forming an angle of less than 180 degrees between them and defining periphery having a uniformly varying orientation (i.e. formed by the "v shaped" of each face with different tapers) ('752, figure 5). Regarding claims 12, 13 and 15, SATRAN ET AL teaches said cutting insert being held in a tool holder for a whereby the tool holder comprises a seat including a bottom, associated with insert clamping means (not shown but it is well known in the art to clamp the insert with a screw going through it's central through hole), and lateral walls for receiving posterior framing support sides (13) of the insert and the walls of the seat are flared (i.e. the sides that contact the support faces of the insert) in relation to the bottom thus forming, together with the bottom seat surface, an angle slightly exceeding 90 degrees, because the insert has a truncated pyramid shape ('752, figure 2).





***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 6, 11 and 14, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Satran et al. (EP 0548752 A1).

Regarding claims 3,4 and 6, SATRAN ET AL teaches the claimed invention (i.e. lateral faces (13) of a posterior periphery, at least some of which are framing supporting faces on walls of a seat of the tool holder (16)) except for the lateral faces being curved/concave or having varying curvature. It would have been an obvious matter of design choice to make the different portions of the lateral faces of whatever form or shape was desired or expedient depending on the application as long as the toolholder has complementary shape. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results.

Regarding claims 11 and 14, SATRAN ET AL teaches the claimed invention (i.e. insert being held in a toolholder such that the lateral faces are contacted by the walls of the toolholder) except for the lateral faces and the walls being inclined at an angle of 65-85 degrees. It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose an inclination for the lateral face of the insert and a complementary angle of the walls of the toolholder that mates with the lateral faces depending on the machining operation, type of insert as well as size, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/S. A./  
Examiner, Art Unit 3722

2/11/08

/Monica S. Carter/  
Supervisory Patent Examiner, Art Unit 3722